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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,010	06/26/2003	Ed Austin	39262/285776	4956
30559	7590	01/11/2006		
CHIEF PATENT COUNSEL SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116			EXAMINER SHAFFER, RICHARD R	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,010

Applicant(s)

AUSTIN ET AL.

Examiner

Richard R. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 6-15, 22, 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 16-19, 21, 23-25 and 28-33 is/are rejected.
- 7) ☒ Claim(s) 4 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/21/04, 10/7/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of the combination of species as shown in Figures 15-18 in the reply filed on November 25th, 2005 as well as the telephone interview between Attorney Geoffrey Gavin and Examiner Richard Shaffer on January 9th, 2006 is acknowledged.

Claims 6-15, 22, 26, and 27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected combination of species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 25th, 2005 and further clarified on January 9th, 2006.

Claim Objections

Claim 3 is objected to because of the following informalities: It recites "relative" in the second line without any additional information as to what the second member is relative to. It was interpreted in light of claim 1 for prosecution. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 16-19, 21, 23, and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Faccioli, et al (PCT Publication WO 00/40163).

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Faccioli, et al disclose an external fixation apparatus comprising: a first member (3) attachable to the tibia (Figure 2B) by pins (5); a second member (1 and 2) coupled to the first member through a lockable ball joint (top of 2, bottom of 3, Figure 2B), wherein the unitary stem section 2 can be translated in at least two transverse directions relative to the longitudinal axis (the two ball joints on both ends of section 2 allow the member to translate), a pin clamp (40, 50) coupled to and rotatable about the second member and attachable to the talus or calcaneus; wherein the second member has a shaft (35) extending transversely including a hole (which extends through the radius) for receiving the locator pin (37) which is removed by pulling (inherent by Figure 3); a hole (38) within the first jaw (40) of the pin clamp that receive the shaft, a first bolt (43) that passes through an opening in the first (4) and second (50) jaws to interfere with the rotation of the pin clamp about the second member; and second and third (59) bolts to hold the two jaws parts together. In regard to claims 30-33, see Page 1, Line 25 through Page 2, Line 27 with regard to the previous statements of functionality.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faccioli, et al in view of Wagenknecht (US Patent 5,160,335).

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Faccioli, et al discloses all of the claimed limitations except for the use of biasing elements received within the openings of the two jaws. Wagenknecht teaches (Column 6, Lines 37-43) that use of springs (Figure 6) in the openings of jaws facilitate the introduction of pins through a clamp intended to connect to bone. This is the same motivation set forth by applicant for using springs or another biasing element in the current application. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include springs or an equivalent biasing element in the device of Faccioli, et al in order to facilitate the introduction of bone pins through the clamp.

Allowable Subject Matter

Claims 4 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday during (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Shaffer
January 9th, 2006



EDUARDO O. ROBERT
PRIMARY EXAMINER